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OFFICE OF PETITIONS

In re Application of :
John M. Pinneo :
Application No. 09/728,942 : **ON PETITION**
Filed: December 1, 2000 :
Attorney Docket No. PI-008 :

This is a decision on the petition to revive under 37 CFR 1.137(b) pursuant to 37 CFR 1.137(f), filed June 2, 2003, and the paper titled "Request for Refund of Petition Fee", also filed June 2, 2003, which is being treated as a petition for a refund under 37 CFR 1.181 and as a petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.4(b).

The petition to revive under 37 CFR 1.137(b) is **GRANTED**.

The petition for a refund under 37 CFR 1.181 is **DISMISSED**.

The petition under 37 CFR 1.183 is **DISMISSED**.

Consideration of the petitions under 37 CFR 1.137(b), 37 CFR 1.181, and 37 CFR 1.183 follows.

Petition Under 37 CFR 1.137(b):

Petitioner states that the instant patent is the subject of a PCT international application filed on November 21, 2001. However, the US Patent and Trademark Office was unintentionally not notified of this filing within 45 days subsequent to the filing of the PCT application.

In view of the above, this application became abandoned pursuant to 35 USC 122(b)(2)(B)(iii) and 37 CFR 1.213(c) for failure to timely notify the Office of the filing of an application in a foreign country, or under a multilateral international agreement, that requires publication of applications 18 months after filing.

A petition under to revive under 37 CFR 1.137(b) pursuant to 37 CFR 1.137(f) must be accompanied by:

- (1) the reply, which is met by the notification of such filing in a foreign country or under a multinational treaty;
- (2) the petition fee as set forth in 37 CFR 1.17(m); and
- (3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional.

The instant petition has been found to be in compliance with 37 CFR 1.137(f). Accordingly, the failure to timely notify the Office of a foreign or international filing within 45 days after the date of filing of such foreign or international application as provided by 35 USC 122(b)(2)(B)(iii) and 37 CFR 1.213(c) is accepted as having been unintentionally delayed.

Petition Under 37 CFR 1.181:

As to the arguments that no specific notice is required and that filing an international application in the United States Receiving Office was a notification of foreign filing, these arguments are not persuasive. 37 CFR 1.213(c) requires the applicant to provide notice, and 37 CFR 1.4(b) provides that each application must be complete in itself. An international application would not be placed into the file of an application that it relies upon for the benefit of an earlier filing date, and so applicant was required to file a separate paper pursuant to 37 CFR 1.4(b) in the above-identified application. Therefore, the mere filing of a PCT application is not the notification required by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c). Petitioner's attention is also directed to 37 CFR 1.4(c), which states:

Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry, or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

Pursuant to 37 CFR 1.4(c), the separate paper was required to address a distinct subject, so a notification of foreign filing was required to be on a separate paper from another matter (such as a new application). Filing a copy of the international application in the above-identified application would not have constituted notice of the foreign filing.

On November 21, 2001, a Patent Cooperation Treaty application, Application No. PCT/US01/43144, was filed. A review of the contents of the file of the above-identified application shows that no notification of the filing of the PCT application was filed within 45 days after the filing date of the PCT application. As a result of petitioner's failure to provide timely notice of the filing of the PCT application, pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c), the above identified application became abandoned at midnight, Monday January 7, 2002 (January 5, 2002 being a Saturday).

Petition Under 37 CFR 1.183:

Lastly, in the event that the Commissioner did not agree with petitioner's arguments, petitioner has requested that the Commissioner suspend the operation of 37 CFR 1.4(b) pursuant to 37 CFR 1.183. A petition to waive or suspend a requirement of the rules requires petitioner to establish that this is an extraordinary situation where justice requires suspension of the rules. Petitioner has not met this showing. Petitioner has a remedy in this instance - file a petition under 37 CFR 1.137(b) pursuant to 37 CFR 1.137(f).


Furthermore, the rules and statutory provisions governing the operations of the U.S. Patent and Trademark Office require payment of a fee on filing each petition for the revival of an application. See 35 U.S.C. § 41(a)(7). As this is a statutory requirement, it can **not** be waived.

Conclusion:

The previous Request and Certification under 35 USC 122(b)(2)(B)(I) has been rescinded. A Notice Regarding Rescission of Nonpublication Request indicating a projected publication date of November 13, 2003 accompanies this decision on petition.

The application is being forwarded to Technology Center 1700 to await for applicant's reply to the Office action mailed May 20, 2003.

Telephone inquiries regarding this decision should be directed to Petitions Attorney Cliff Congo at (703) 305-0272.


Beverly Flanagan
Supervisory Petitions Examiner
Office of Petitions

Enc: Notice Regarding Rescission of Nonpublication Request and
Notice of Foreign Filing (2 pages)